

Remarks

Examiner Interview

In a telephone interview with the Examiner on January 12, 2009, the finality of the Office Action mailed on October 31, 2008 was discussed. Applicant thanks the Examiner for scheduling and conducting the interview. During the interview, the finality of the Office Action of October 31, 2008 was withdrawn. The Interview Summary mailed on January 21, 2009 confirms that the finality of the Office Action mailed October 31, 2008 has been withdrawn.

Withdrawal of Final Rejection

Applicant respectfully submits that the Final Rejection issued on the application is improper based on MPEP 706.07(a) and should be withdrawn.

MPEP 706.07(a) provides:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). (MPEP 706.07(a), emphasis added).

Independent claim 29 was not amended in the previous response, yet has now been rejected on a new ground of rejection (35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement) and the rejection has been made final. Thus, the Final Rejection is improper under MPEP 706.07(a) and should be withdrawn. As noted previously, in the Interview Summary mailed on January 21, 2009, the finality of the Office Action mailed October 31, 2008 has been withdrawn.

Response to Final Office Action mailed October 31, 2008

Application No.: 09/903,973

Attorney Docket Number: 164052.02

I. Rejection of Claims 7, 9 and 29 Under 35 U.S.C. §112, First Paragraph,

Claims 7, 9 and 29 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Regarding, the rejection under 35 U.S.C. §112, first paragraph, the Final Office Action provides:

Claims 7, 9, and 29 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors), at the time the application was filed, had possession of the claimed invention.

Claim 7 recites as amended "wherein the status indicates in real time whether the one or more currently available broadcast television programs is currently active or inactive". In the instant specification it is noted that broadcast programming data and IP content are *initially* received by the client system and "alerts ... inform the viewer of programs *not currently* being viewed" (see instant spec [78]). From this information it is unclear that said program is currently being broadcast or was just initially broadcast, additionally it is difficult to discern the currency of the active status given that the program is currently not being viewed, it is not certain that it is being broadcast. The text of the specification does not support the allegations that are being claimed. (Final Office Action at page 3).

Applicant respectfully submits that support for the "wherein the status indicates in real time whether the one or more currently available broadcast television programs is currently active or inactive" can be found, for example, in the Specification as follows:

For creating an enhanced user experience, the IP data is augmented in some fashion before it is routed to the client system. For example, real-time event data relating to the

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active status of available television programming may be inserted in the IP stream and provided to the client system. Such data is used to create various real-time tunable alerts, triggers or filters and the like. The client system processes such data to create real-time visual indicators and cues and presents the visual indicators and cues together with the IP data. Thus, for example, data corresponding to current status indicators of available sport events and for invoking specific actions are provided to the client system. (Specification at page 13, lines 3-11).

Thus, the amendment to claims 7 and 16 in the Amendment filed on August 18, 2008 are supported by the Specification of the subject application.

Applicant respectfully submits that claims 7, 9 and 29 comply with the written description requirement of 35 U.S.C. §112, first paragraph, which provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The scope of claim 7, as previously amended, -- wherein the status indicates in real-time whether the one or more currently available broadcast television programs is currently active or inactive -- enables a person skilled in the art to make and use the invention. Further, the scope of claim 29, as previously amended, -- presenting a visual cue to the user based on the IP data on a display device, wherein the visual cue comprises a real-time event alert informing the user of an action that is about to occur in one or more currently available broadcast television programs -- enables a person skilled in the art to make and use the invention. Applicant respectfully submits that the limitation “that is about to occur” of claim 29 clearly is based on received IP data. Thus, if the IP data

includes information regarding an action “that is about to occur” that information can be provided to the user. Applicant respectfully submits that presentation of a real-time event alert informing the user of an action *that is about to occur* based on received IP data is not a “prediction-based” alert.

Withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 7-9, 11-13, 16, 18 and 29 Under 35 U.S.C. §102(e) as Being Anticipated by U.S. Patent Number 7,165,098 to Boyer

Claims 7-9, 11-13, 16, 18 and 29 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Number 7,165,098 to Boyer (“Boyer”). Applicant respectfully traverses the rejection as follows.

Independent Claims 7 and 29

Claim 7 is directed to a method for presenting enhanced broadcast television programming. Claim 7 recites, *inter alia*, receiving enhanced Internet protocol (IP) data including an event identifier associating the IP data with one of the plurality of television listings, wherein the IP data corresponds to broadcast television programming currently available to a viewer; and, presenting a visual cue to the viewer based on the IP data on a video display, wherein the visual cue comprises an active status indicator indicating a status of one or more currently available broadcast television programs, wherein the status indicates in real-time whether the one or more currently available broadcast television programs is currently active or inactive. Boyer fails to teach these features.

Claim 29 is directed to a method for delivering enhanced broadcast television programming data. Claim 29 recites, *inter alia*, receiving enhanced Internet protocol (IP) data including an event identifier associating the IP data with one of the plurality of television listings, wherein the IP data corresponds to broadcast television programming

currently available to a user; and, presenting a visual cue to the user based on the IP data on a display device, wherein the visual cue comprises a real-time event alert informing the user of an action that is about to occur in one or more currently available broadcast television programs. Boyer fails to teach these features.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). *See*, MPEP §2131.

In *Brown v. 3M*, 265 F. 3d 1349, (Fed. Cir. 2001), the Court of Appeals noted:

Anticipation under 35 U.S.C. §102 means lack of novelty, and is a question of fact. To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

(*Brown*, emphasis added, *see also*, *In re Davis Buszard et al.*, 2006-1489 (Fed. Cir. Sept. 27, 2007).

Boyer teaches an on-line scheduling application allows users to personalize how television-related, entertainment-related, and social event related information is provided. (Boyer, Abstract). Users may select one or more sources from which the information is obtained. (Boyer, Abstract). One or more of the personalization features of the

scheduling application may be incorporated into an on-line television programming guide. (Boyer, Abstract).

Regarding claims 7 and 29, the Final Office Action provides:

presenting a visual cue to the viewer based on the IP data on a video display wherein the visual cue comprises an active status indicator indicating the status of one or more currently available broadcast television program. wherein the status indicates in realtime whether the one or more currently available broadcast television programs IS currently active or inactive Said visual cues based on IP data comprise an indicator (claim 7) and an event alert (claim 29) both terms represent the *cue*, both terms represent an indication on the display of some event, in fact, support for such similarity is given in the instant spec (see [78]) where it is recited "*alerts* or other real-time *indicators* that inform the viewer of *certain events* or the *active status* of..." denoting no difference in their use). Additionally, claim 7 recites an "active status ...", wherein the status indicates in realtime ... " further noting that said "active" indicator is a "real-time" indicator (as defined by said claims), therefore the rejection clearly reads on claim 7 and claim 29)... (Final Office Action at page 5).

With respect to claim interpretation, MPEP 2111 provides:

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." >The Federal Circuit's en banc decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard:

The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their

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broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1).

* * *

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (The Board's construction of the claim limitation "restore hair growth" as requiring the hair to be returned to its original state was held to be an incorrect interpretation of the limitation. The court held that, consistent with applicant's disclosure and the disclosure of three patents from analogous arts using the same phrase to require only some increase in hair growth, one of ordinary skill would construe "restore hair growth" to mean that the claimed method increases the amount of hair grown on the scalp, but does not necessarily produce a full head of hair.). (MPEP 2111, emphasis added).

To the extent that the Final Office Action is interpreting "real-time" to mean "active", the interpretation is not reasonable. Further, the interpretation of the claim limitation "wherein the status indicates in real-time whether the one or more currently available broadcast television programs is currently active or inactive" advanced in the Final Office Action would not be consistent with the Specification. Applicant respectfully submits that "in real-time" describes how the status (active or inactive) is presented.

Applicant further submits that one skilled in the art would not interpret “in real-time” as recited in claims 7 and 29 to mean “active”. The Specification does not use these terms interchangeably – paragraph [0078] of the Specification (relied upon in the Final Office Action) provides:

[0078] FIG. 7b shows an operational flow chart of an application program, executing on the client system 100, to create a navigation guide according to another embodiment of the invention. In this embodiment, the enhanced content is associated with a corresponding television program at the client system. Execution of the program begins at step 740. In this step, broadcast programming data and IP content are initially received by the client system. As noted above, the programming data and the IP data are associated with their own unique identification information. Next, at step 741, the system operates to create navigation elements and other enhanced content based on the received IP content. As explained below, this step includes creating certain buttons, Alerts or other real-time indicators that inform the viewer of certain events or the active status of related television programs not currently being viewed. In addition, the system maps the program and content identification data to permit the IP content to be wrapped around the television program as presented to the viewer. Thereafter, at step 742, the client system 100 presents a navigation guide having one or more navigation elements on the display. In many instances, the system also presents a viewing window for displaying a currently viewed program. (U.S. Published Application Number 2002/0157099).

Finally, Merriam-Webster’s online dictionary defines “real time” as:

the actual time during which something takes place <the computer may partly analyze the data in *real time* (as it comes in) — R. H. March> <chatted online in *real time*>

Thus, interpretation of “in real-time” to mean “active” would not be a reasonable interpretation. (*See*, MPEP 2111).

Continuing, the Final Office Action does not provide a cite to where Boyer teaches the limitation of “wherein the status indicates in real-time whether the one or more currently available broadcast television programs is currently active or inactive”. Applicant respectfully submits that Boyer specifically teaches periodic (e.g., once a day) updating of scheduling information:

Media library 12 and data server 14 may be interconnected with transmission server 16 via internal network 18. Media library 12, data server 14, network 18, and transmission server 16 may make up scheduling system 19. If desired, the data and multimedia storage and processing functions of media library 12, data server 14, and transmission server 16 may be provided by a single, integrated system. Scheduling information may, for example, be stored on data server 14 in a relational database format and may be stored on transmission server 16 in an object-oriented database format. A building process implemented in the C++ programming language can be used to periodically (e.g., once a day) build a temporary data set of scheduling information (e.g., a seven-day to one-month data set) for storage on transmission server 16. (Boyer, col. 8, lines 30-40, emphasis added).

Thus, Boyer does not teach wherein the status indicates in real-time whether the one or more currently available broadcast television programs is currently active or inactive as recited in claim 7. Further, Boyer does not teach wherein the visual cue comprises a real-time event alert informing the user of an action that is about to occur in one or more currently available broadcast television programs as recited in claim 29.

Since claims 7 and 29 recite features not taught by the reference of record, claims 7 and 29 patentably distinguish over the reference of record and are in condition for

allowance. Furthermore, dependent claims 8, 9, 11-13 also patentably distinguish over the reference of record and are in condition for allowance.

Independent claim 16

Claim 16 is directed to a client system for receiving a broadcast television navigation service. Claim 16 recites, *inter alia*, means for receiving Internet protocol (IP) data that is not provided in a program band of the broadcast television programming, wherein the IP data corresponds to broadcast television programming currently available to a viewer; and, means for linking the broadcast television programming with the Internet protocol data; means for presenting a visual cue to a viewer based on the IP data on a display, wherein the visual cue comprises an active status indicator indicating a status of one or more currently available broadcast television programs, wherein the status indicates in real-time whether the one or more currently available broadcast television programs is currently active or inactive. Boyer does not teach these features.

As discussed in greater detail with respect to claims 7 and 29 above, Boyer teaches an on-line scheduling application allows users to personalize how television-related, entertainment-related, and social event related information is provided. (Boyer, Abstract).

Regarding claim 16, the Final Office Action provides:

wherein the status indicates in real-time whether the one or more *currently* available broadcast television programs is *currently* active or inactive: receiving a viewer selection of the visual cue; and tuning to the channel associated with the event identifier in response to viewer selection of the visual cue" (Fig. 4 with visual cues for setting the programs based on the active status as for today's schedule, this week, this month, reminder delivery etc. and/or as in Fig. 6a for active status of *currently* available program as title, actor,

channel, start time or rating etc. or the genre of the program(s), display is means). (Final Office Action at pages 7 and 8).

As discussed previously, to the extent that the Final Office Action is interpreting “real-time” to mean “active”, the interpretation would not be a reasonable interpretation. (*See*, MPEP 2111).

Fig. 4 of Boyer is an illustrative main menu page for an on-line scheduling application. (Boyer, col. 10, lines 1-4). As noted previously, Boyer specifically teaches periodic (e.g., once a day) updating of scheduling information. (Boyer, col. 8, lines 30-40). Applicant respectfully submits that Boyer does not teach wherein the status indicates in real-time whether the one or more currently available broadcast television programs is currently active or inactive as recited in claim 16.

Since claim 16 recites features not taught or suggested by the reference of record, claim 16 patentably distinguishes over the reference of record and is in condition for allowance. Furthermore, dependent claims 17 and 18 also patentably distinguish over the reference of record and are in condition for allowance.

III. Rejection of Claim 17 Under 35 U.S.C. §103(a) As Being Obvious Over Boyer in view of U.S. Patent 7,028,327 to Dougherty

Claim 17 was rejected under 35 U.S.C. §103(a) as being obvious over Boyer in view of U.S. Patent 7,028,327 to Dougherty (“Dougherty”). Applicant respectfully traverses the rejection of these claims.

Claims 17 is a dependent claim and is allowable based on dependency from allowable independent claim 16 as described above. Accordingly, Applicant respectfully requests that the rejection of these claims be withdrawn.

Conclusion

For the reasons set forth above, claims 7-9, 11-13, 16-18 and 29 patentably and unobviously distinguish over the reference and are allowable. An early allowance of all claims is earnestly solicited.

Respectfully submitted,

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